

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

(HC)

APPLICATION NO.	FILING DATE	PROKOF	FIRST NAMED INVENTOR	D	ATTORNEY DOCKET NO.
08/913, 510	12/02/97				

000570 HM12/0816  
PANITCH SCHWARZE JACOBS & NADEL  
ONE COMMERCE SQUARE 22ND FLOOR  
2005 MARKET STREET  
PHILADELPHIA PA 19103



WITZ, EXAMINER

ART UNIT	PAPER NUMBER
----------	--------------

08/16/98

**DATE MAILED:**

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

<b>Office Action Summary</b>	Application No. <b>08/913,918</b>	Applicant(s) <b>Prockop et al.</b>
	Examiner <b>Jean C. Witz</b>	Group Art Unit <b>1651</b>

Responsive to communication(s) filed on Jun 1, 1999

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-68 is/are pending in the application.

Of the above, claim(s) 1-36 and 39-54 is/are withdrawn from consideration.

Claim(s) \_\_\_\_\_ is/are allowed.

Claim(s) \_\_\_\_\_ is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims 37, 38, and 55-68 are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been

received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 1651

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Group V, Claims 37-38 in Paper No. 10 is acknowledged. Claims 1-36 and 39-54 are withdrawn from consideration as being drawn to a non-elected invention. Paper #10 was accompanied by a preliminary amendment A, filed as Paper #11, in which claims 55-68 were added. Claims 55-68 will be included in Group V; however, in view of said claims, the following election of species has been required.
2. This application contains claims directed to more than one species of the generic invention. These species are deemed to lack unity of invention because they are not so linked as to form a single general inventive concept under PCT Rule 13.1.

The species are as follows:

a gene construct comprising a nucleotide sequence that encodes a beneficial protein as set forth in claim 56: a type II procollagen, a type II collagen, cystic fibrosis protein, human growth hormone, an obesity factor, and a human Factor VIII.

Applicant is required, in response to this action, to elect a single species to which the claims shall be restricted if no generic claim is finally held to be allowable. The response must also identify the claims readable on the elected species, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered non-responsive unless accompanied by an election.

Art Unit: 1651

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

3. The claims are deemed to correspond to the species listed above in the following manner:
  - a type II procollagen - claims 37 and 56
  - a type II collagen - claims 37 and 56
  - a cystic fibrosis protein - claims 37 and 56
  - a human growth hormone - claims 37 and 56
  - an obesity factor - claims 37 and 56
  - a human Factor VIII - claims 37 and 56

The following claim(s) are generic: Claims 37-38, 55, and 57-68.

4. The species listed above do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, the species lack the same or corresponding special technical features for the following reasons: Each nucleotide sequence encodes a separate and distinct beneficial protein having a different amino acid sequence and a different physiological effect. The nucleotide sequence for one protein is not necessary for the production of the stromal cells containing a gene construct for another protein. Therefore, there is no same or corresponding special technical feature between the species.

Art Unit: 1651

5. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

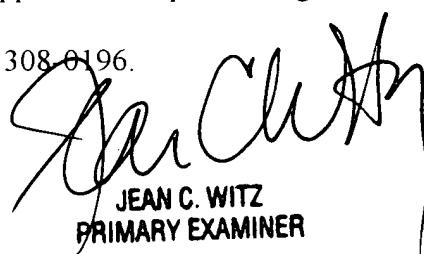
6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

7. The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1651.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jean C. Witz whose telephone number is (703) 308-3073. The examiner can normally be reached on Monday through Thursday from 6:30 a.m. to 4:00 p.m. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Wityshyn, can be reached on (703) 308-4743. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.



JEAN C. WITZ  
PRIMARY EXAMINER